THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte QUOE PHAN and MARLENE L. PAUL

_____

Appeal No. 2000-0433
Application 08/741,070

_____

ON BRIEF

_____

Before CALVERT, STAAB, and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-20 which are all the claims pending in this application. The appellants' invention relates to a

method for attaching a fixation member to an optic of an intraocular lens which includes the step of securing the lens bonding region of the fixation member free of enlarged anchor structures to an optic member having a recess by reducing the size of the recess. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

THE PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kaplan et al. (Kaplan)	4,668,446	May 26, 1987
Doyle et al. (Doyle)	5,423,929	Jun. 13, 1995
Korgel et al (Korgel)	5,523,029	Jun. 4, 1996

THE REJECTIONS

Claims 1-15 and 17-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Korgel in view of Kaplan.

Claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Korgel and Kaplan as applied to claims 1-15 and 17-19 above and further in view of Kaplan.

Claim 20 stands rejected under 35 U. S.C. § 103 as being

unpatentable over Korgel in view of Doyle.

Rather than reiterate the conflicting view points advanced by the examiner and the appellants regarding the above noted rejections, we make reference to the examiner's answer (Paper No. 21, mailed August 20, 1999) for the examiner's complete reasoning in support of the rejections, and to the appellants' Brief (Paper No. 20, filed June 11, 1999) and the appellants' Reply Brief (Paper No. 23, filed October 25, 1999) for the appellants' arguments thereagainst.

OPINION

In reaching our decision on this appeal we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determination which follows.

All of the examiner's rejections are made pursuant to 35 U.S.C. § 103. We initially note that the examiner bears the initial burden of presenting a prima facie case of obviousness under 35 U.S.C. § 103. See In re Rijckaert, 9 F.3d 1531,

1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443,1444 (Fed. Cir. 1992). A prima facie case of obviousness is established by presenting evidence indicating that the prior art teachings would have appeared sufficient for one of ordinary skill in the relevant art having those teachings before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the prior art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988), In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

Additionally, a rejection based on § 103 must rest on a factual basis with these facts interpreted without hindsight reconstruction of the invention from the prior art. The

examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellants' disclosure as a blueprint to reconstruct a claimed invention from the isolated teachings in the prior art. See e.g., Grain Processing Corp. v. America Maize-Prods. Co., 845 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

With this background, we first consider the examiner's rejection of claims 1-15 and 17-19 as being unpatentable over Korgel in view of Kaplan. In support of this rejection, the examiner states:

> Korgel et al meets the claim language except for the reducing the size of the recess step as claimed; it is noted that the enlarged end structure is formed only after insertion of the haptic into the attachment hole. Kaplan et al teaches that the process of enlarging optics with organic liquids prior to haptic insertion then re-reducing them by solvent removal has been known to the art; see Col. 7, line 39 to Col. 8, line 28. Hence, it is the Examiner's position that it would have been obvious to swell the optic of Korgel et al before haptic

> insertion and later reduce the recess size by solvent removal to better secure it into the optic as taught by Kaplan et al [examiner's answer at page 4].

The appellants argue that neither Korgel nor Kaplan disclose securing a fixation member having a lens bonding region free of an enlarged anchor structure to an optic member as recited in all of the claims on appeal.

Korgel discloses a method of attaching a haptic to an optic of an intraocular lens which includes the steps of inserting the haptic fully into the hole in the haptic, then aiming and firing a laser at the end portion of the haptic to swell and interlock the end portion within the hole. (Column 5, lines 30-37).

Kaplan discloses a process for making soft contact intraocular lenses which includes the step of forming a lens, forming a peripheral bore in the lens, swelling the lens with an organic fluid and inserting an end of a haptic into the peripheral bore of the swollen lens. Kaplan discloses that the end of the haptic has an enlarged transverse cross-sectional portion. (Column 2, lines 38-47).

As such, we agree with the appellant that the combined teachings of Kaplan and Korgel do not disclose a method for attaching a fixation member to an optic of a intraocular lens which includes the step of "securing said lens bonding region *free of enlarged anchor structures* to said optic member by reducing the size of said recess," as recited in claim 1. Clearly, both references require that the end of the haptic have an anchor structure with an enlarged end.

In view of the foregoing, we will not sustain the examiner's rejection of claim 1 or claims 2-13 dependent thereon. In addition, we will not sustain the examiner's rejection of claim 14 and claim 15 dependent thereon because claim 14 also recites that the lens bonding region of the fixation member is free of enlarged anchor structures.

We turn next to the examiner's rejection of claim 16 under 35 U.S.C. § 103 as being unpatentable over Korgel in view of Kaplan. In support of this rejection the examiner states that it would have been obvious to use cross-linked silicone in the Kaplan device absent a showing that the use

of cross-linked silicone instead of silicon would lead to unexpected results. However, claim 16 is dependent on claim 14 which, like claim 1, recites the step of securing the lens bonding region *free of enlarged anchor structure* to the optic member. As we have discussed above, it is our view that this step is not disclosed in either Korgel or Kaplan. As such, we will not sustain this rejection.

We turn lastly to the examiner's rejection of claim 20 under 35 U.S.C. § 103 as being unpatentable over Korgel in view of Doyle.

In support of this rejection the examiner states:

> Korgel et al meets the claim language, but fails to disclose a step of forming a recess without removing material as claimed. Doyle et al, however, teaches that it has been known to use the same technique of forming a recess as is set forth in the present specification. That is, a needle is used to puncture a hole into the lens; see Col. 8, lines 1-7 and Col. 12, lines 5-9 . . . it would have been obvious to use the needle puncturing technique of Doyle et al on Korgel's lens for the same reasons Doyle et al uses the same and because it would not leave any removed particulate
>
> matter near to hole as drilling would.[examiner's answer at page 5-6]

The appellants argue that if one of ordinary skill in the art were to combine Korgel and Doyle, the lens bonding regions

of the fixation members would have both coating and enlarged anchor
structures and that claim 20 requires that the lens bonding regions have no coating and no enlarged anchor structure.

We do not agree with the appellants that claim 20 requires that the lens bonding region has no enlarged anchor structures. Claim 20 recites "placing the lens bonding region including no coating and no enlarged anchor structures into said recess." As such, claim 20 requires only that the fixation member has no enlarged anchor structure when it is placed in the recess of the optic. Korgel teaches at column 5, lines 30-37 that the haptic end portion is swollen by the laser energy once it is placed in the recess of the optic. As such, Korgel clearly discloses placing a haptic without an enlarged anchor structure in the recess of the optic. In addition, Korgel does not disclose a coating on the haptic. Therefore we will sustain the examiner's rejection of claim 20.

In summary, the examiner's rejections of claims 1-19 are reversed and the examiner's rejection of claim 20 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED IN PART

IAN A. CALVERT Administrative Patent Judge	)	
LAWRENCE J. STAAB Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MURRIEL E. CRAWFORD Administrative Patent Judge	)	

MEC:pgg
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